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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/725,053 | 12/02/2003 | Tadahiro Kegasawa | Q78706 | 2949 |

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| EXAMINER | |
|---|---|
| EASHOO, MARK | |
| **ART UNIT** | **PAPER NUMBER** |
| 1732 | |

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/725,053 | KEGASAWA ET AL. | |
| | Examiner | Art Unit | |
| | Mark Eashoo, Ph.D. | 1732 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *24 April 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 1cm.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of claims group I, claims 1-5, in the reply filed on 24-APR-2006 is acknowledged.

Applicant's amendment filed on 24-APR-2006 cancelled non-elected claims 6-9.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically:

Claim 1 recites the term "the resin" as forming both "the middle portion" and "the edge portions". As such, the claim is indefinite because it cannot be clearly ascertained if the resins at the edges are intended to be the same or different resins. For the purpose of considering prior art, the limitation(s) has been interpreted as 'different resins' or first and second resins.

Claim 2 is indefinite because it cannot be clearly ascertained how the middle and edge portions are adjusted according to a MFR difference when: 1.) the resin appears to be same for each portion and/or 2.) no limitation is recited indicating an MFR difference is present. Furthermore, the breadth of the term "adjusted" is extremely broad and the metes and bounds of the adjustment cannot be adequately determined.

Claim 3 is indefinite because it cannot be clearly ascertained how the middle and edge portions are adjusted according to a extrusion rate difference when: 1.) the resin appears to be same for each portion and/or 2.) no limitation is recited indicating an extrusion rate difference is present. Furthermore, the breadth of the term "adjusted" is extremely broad and the metes and bounds of the adjustment cannot be adequately determined.

Claim 4 is indefinite because it cannot be clearly ascertained how the middle and edge portions are adjusted according to a temperature difference when: 1.) the resin appears to be same for each portion and/or 2.) no limitation is recited indicating an temperature difference is present. Furthermore, the breadth of the term "adjusted" is extremely broad and the metes and bounds of the adjustment cannot be adequately determined.

Claim 5 is indefinite because it cannot be clearly ascertained how the middle and edge portions are adjusted according to a film width when the resin appears to be same for each portion. Furthermore, the breadth of the term "adjusted" is extremely broad and the metes and bounds of the adjustment cannot be adequately determined.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Thompson (US Pat. 4,348,346).

Thompson teaches the claimed process of forming a film, comprising: joining a middle portion and edge portions of a film, in a molten state, such that the edge portion enclose both edges of the film main body (Figs. 1 and 4); and extruding the joined resins through a die to form a film (Figs. 1 and 4).

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson (US Pat. 4,348,346) in view of Kegasawa et al. (US Pat. 6,203,742).

Thompson teaches the basic claimed process as set forth above regarding claim 1.

Thompson does not teach adjusting the degree of enclosing according to a difference in MFR, temperature, extrusion rate, or film/die width. However, Kegasawa et al. suggest that it is critical/necessary to know the relationship between rheological characteristics (ie. viscosity, MFR, etc.), temperature, and flow rate in order to balance the extrusion pressure along the width of the film/die, including the pressure difference at the ends of the die/film (4:20-5:22). It is noted that MFR is directly related to viscosity and a person of ordinary skill in the art would

readily be able to make the association between the two terms. Furthermore, since Kegasawa et al. refers to adjusting the pressure across the die width by varying the other aforementioned parameters, "adjustment of the width" is readable or intrinsic upon adjustment of the other parameters. Thompson and Kegasawa et al. are combinable because they are from the same field of endeavor, namely, flat film extrusion. At the time of invention a person of ordinary skill in the art would have found it obvious to have adjusted the either the viscosity/MFR, temperature, or flow rate, as taught by Kegasawa et al., in the process of Thompson, in order to adjust the size and degree of confluence/intermingling of the different resins.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached form PTO-892.

*Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,896,832. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3 of US Pat. substantially teach joining a middle portion and edge portions of a film, in a molten state, such that the edge portion enclose both edges of the film main body and extruding the joined resins through a die to form a film.

Claims 2-5 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 6,896,832 in view of Kegasawa et al. (US Pat. 6,203,742).

Claims 1-3 of US Pat. 6,896,832 substantially teach joining a middle portion and edge portions of a film, in a molten state, such that the edge portion enclose both edges of the film main body and extruding the joined resins through a die to form a film.

Claims 1-3 of US Pat. 6,896,832 does not teach adjusting the degree of enclosing according to a difference in MFR, temperature, extrusion rate, or film/die width. However, Kegasawa et al. suggest that it is critical/necessary to know the relationship between rheological characteristics (ie. viscosity, MFR, etc.), temperature, and flow rate in order to balance the extrusion pressure along the width of the film/die, including the pressure difference at the ends of the die/film (4:20-5:22). It is noted that MFR is directly related to viscosity and a person of ordinary skill in the art would readily be able to make the association between the two terms. Furthermore, since Kegasawa et al. refers to adjusting the pressure across the die width by varying the other aforementioned parameters, "adjustment of the width" is readable or intrinsic upon adjustment of the other parameters. Claims 1-3 of US Pat. 6,896,832 and Kegasawa et al. are combinable because they are from the same field of endeavor, namely, flat film extrusion. At the time of invention a person of ordinary skill in the art would have found it obvious to have adjusted the either the viscosity/MFR, temperature, or flow rate, as taught by Kegasawa et al., in the process of claims 1-3 of US Pat. 6,896,832, in order to adjust the size and degree of confluence/intermingling of the different resins.

*Correspondence*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (571) 272-1197. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on (571) 272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark Eashoo, Ph.D.
Primary Examiner
Art Unit 1732

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Jul. 3, 06

03/JUL/06